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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/827,489
Filing Date: April 06, 2001
Appellant(s): MAKELA ET AL.

MAILED

MAY 04 2005

Technology Center 2600

Geza C. Ziegler, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/19/05.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-40 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9a) *Prior Art of Record*

5,559,860	MIZIKOVSKY	9-1996
5,848,356	JAMBHEKAR ET AL.	12-1998
6,018,671	BREMER	1-2000

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4,481,382	VILLA_REAL	11-1984
5,327,486	WOLFF ET AL.	7-1994

(9b) New Prior Art

No new prior art has been applied in this Examiner's Answer.

(10) Grounds of Rejection

(a) The following ground(s) of rejection are applicable to the appealed claims as given in the 2/17/04 Office Action:

10a.1. Claims 1,4-9, 12-13,15-21 and 23-40 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Mizikovsky** (US 5,327,486).

As to Claims 1,20,23-25,29,33 and 37, with respect to Figures 1-2 and 5, **Mizikovsky** teaches a method for replying to a call coming to a portable terminal wherein, in response to the incoming call,

the portable terminal identifies the caller on the basis of caller ID (an identification information), or

directs the incoming call to voice mail (another answering service),

said reply having a form selectable from accessories (a plurality of forms of communication), and

wherein said step of identifying the caller is accomplished by said portable terminal, and said step of sending a reply is accomplished by said portable terminal, said portable terminal

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being capable of performing said step of sending a reply by providing a selected response to said caller exclusively through the action of said portable terminal (Figure 1, label 50, Figure 2, label 114 and Figure 5, label 516).

As to Claim 7, **Mizikovsky** teaches a method in accordance with claim 1, wherein said reply is at least partly formulated based on the identification of the calling party (Figure 5, label 506).

As to Claim 8, **Mizikovsky** teaches a method in accordance with claim 7 wherein a reply is sent to certain identified calling parties only (Figure 5, labels 508,512).

As to Claim 9, **Mizikovsky** teaches a method in accordance with claim 7, wherein the reply to be sent in response to the incoming call is different according to the respective company said call is coming from (Figure 5, labels 508,512,516).

As to Claims 12-13, **Mizikovsky** teaches a method in accordance with claim 7, wherein said identification of the calling party is based on registered caller IDs (a telephone notebook) comprised by the communication (Figure 2, label 106).

As to Claims 26,30,34,38, **Mizikovsky** teaches a portable terminal in accordance with claim 25, wherein said step of taking response action comprises sending a reply to the caller, said reply being a voice message (one of the following: a voice message, e-mail message, facsimile, and an SMS message in the form of a character string) (Col. 8, lines 51-59).

10a.2. Claims 2,6 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky** in view of **Jambhekar et al.** (US 5,848,356).

As to Claims 2,6, **Mizikovsky** teaches a method in accordance with Claim 1, wherein the portable terminal sends said reply immediately in response to an incoming call, and said plurality of forms of communication include a voice message:

Mizikovsky does not teach the following limitation:

“an e-mail message, a facsimile message, and an SMS message in the form of a character string”

However, it is obvious that **Mizikovsky** suggests the limitation. This is because **Mizikovsky** teaches other accessory responses illustrated as peripherals could be used (Col. 7, lines 6-12). In particular, **Mizikovsky** teaches a facsimile peripheral which suggests a facsimile accessory and facsimile message; a multimedia terminal which suggests an e-mail accessory and response; EIA/T1A IS-54 alert messages which suggests a SMS accessory and response.

Jambhekar teaches e-mail, facsimile and SMS messages (Figures 5P and 8A). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add e-mail, facsimile and SMS capabilities to **Mizikovsky**'s invention for providing callers with response messages as taught by **Jambhekar**'s invention in order not to distract a user by sending pre-programmed responses.

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10a.3. Claims 3-5,28,32,36,40 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky** in view of **Bremer** (US 6,018,671).

As to Claim 3, **Mizikovsky** teaches a method in accordance with Claim 1, wherein in response to an incoming call,

Mizikovsky does not teach the following limitation:

“the portable terminal alarms and waits during a certain delay, and if a user during said delay does not answer said call, the portable terminal sends said reply”

However, it is obvious that **Mizikovsky** suggests the limitation. This is because **Mizikovsky** teaches providing users with alert signals and, therefore, waits for a user response (Figure 5, label 510). **Bremer** teaches the limitation (Figure 4, labels 416,420). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add default capability to **Mizikovsky**'s invention for providing callers with default messages as taught by **Bremer**'s invention in order not to keep a caller waiting.

As to Claims 4,28,32,36,40, **Mizikovsky** teaches a method in accordance with claim 1, wherein in response to an incoming call, the portable terminal alarms, and:

Mizikovsky does not teach the following limitation:

“if a user gives a certain key command, the portable terminal sends said reply”

However, it is obvious that **Mizikovsky** suggests the limitation. This is because **Mizikovsky** teaches providing users with alert signals and, therefore, waits for a user response

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(Figure 5, label 510). **Bremer** teaches the limitation (Figure 4, labels 416,418). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add selected message capability to **Mizikovsky's** invention for providing callers with selected messages as taught by **Bremer's** invention in order not to keep a caller waiting.

As to Claim 5, **Mizikovsky** teaches a method in accordance with claim 3, wherein the portable terminal gives a mute soundless alarm (Col. 6, lines 43-50).

10a.4. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky** in view of **Villa-Real** (US 4,481,382).

As to Claim 14, **Mizikovsky** teaches a method in accordance with claim 7:

Mizikovsky does not teach the following limitation:

“wherein a reminder to call the identified calling party will be stored into the portable terminal, in order to be presented to a user later”

However, it is obvious that **Mizikovsky** suggests the limitation. This is because **Mizikovsky** teaches providing selected accessory responses to callers (Figure 5, label 518). **Villa-Real** teaches reminder messages (Col. 1, lines 50-63). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add reminder capability to **Mizikovsky's** invention for alerting users as taught by **Villa-Real's** invention in order to provide reminders to users when calls become due.

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10a.5. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky** in view of **Wolff et al.** (US 5,327,486).

As to Claims 15-17, **Mizikovsky** teaches a method in accordance claim 1, wherein said reply includes:

Mizikovsky does not teach the following limitation:

“time information”

However, it is obvious that **Mizikovsky** suggests the limitation. This is because **Mizikovsky** teaches providing callers with selected user accessory responses (Figure 5, label 518). **Wolff** teaches the limitation (Figures 8-9). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add time capability to **Mizikovsky's** invention for providing callers with selected time-based messages as taught by **Wolff's** invention in order not to keep a caller waiting.

(b) THE FOLLOWING NEW GROUND(S) OF REJECTION ARE APPLICABLE TO THE APPEALED CLAIMS UNDER NEW RULES OF PRACTICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES (37 CFR 41.39)

10b.1. Claims 1,4-9, 12-13,15-21 and 23-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky**.

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As to Claims 1,20,23-25,29,33 and 37, with respect to Figures 1-2 and 5, **Mizikovsky** teaches a method for replying to a call coming to a portable terminal wherein, in response to the incoming call,

the portable terminal identifies the caller on the basis of caller ID (an identification information), or

directs the incoming call to voice mail (another answering service),

said reply having a form selectable from accessories (a plurality of forms of communication), and

wherein said step of identifying the caller is accomplished by said portable terminal, and said step of sending a reply is accomplished by said portable terminal, said portable terminal being capable of performing said step of sending a reply by providing a selected response to said caller through the action of said portable terminal (Figure 1, label 50, Figure 2, label 114 and Figure 5, label 516);

Mizikovsky does not explicitly teach the following limitation:

“providing a selected response to said caller exclusively through the action of said portable terminal”

However, **Mizikovsky** teaches that responses are sent to callers from the Accessories 50 which are not clearly taught to be in the mobile station.

In other words, Mizikovsky does not explicitly teach that the Accessory responses are exclusively sent through the mobile terminal. Also, Mizikovsky does not explicitly teach that the Accessories are integrated into the mobile device.

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Mizikovsky suggests that accessories are peripherals which have been included into the mobile station and which function together to process incoming calls (Col. 3, lines 1-4 and Col. 7, lines 5-7). Further, according to **In re Larson** 144 U.S.P.Q. 347, when parts are rigidly secured together as a single unit, they function as a unitary whole. Further it would be obvious to integrate the peripherals 52 as Accessories into the mobile device so that users are not required to be present at the mobile station for responding to incoming calls.

Therefore, having the cited art at the time the invention was made, it would have been obvious if it is not inherent to one of ordinary skill in the art that the accessories 50 together with the other elements of the mobile station constitute a unitary mobile station and accessory responses from the mobile station are sent exclusively through the mobile station.

As to Claim 7, **Mizikovsky** teaches a method in accordance with claim 1, wherein said reply is at least partly formulated based on the identification of the calling party (Figure 5, label 506).

As to Claim 8, **Mizikovsky** teaches a method in accordance with claim 7 wherein a reply is sent to certain identified calling parties only (Figure 5, labels 508,512).

As to Claim 9, **Mizikovsky** teaches a method in accordance with claim 7, wherein the reply to be sent in response to the incoming call is different according to the respective company said call is coming from (Figure 5, labels 508,512,516).

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As to Claims 12-13, **Mizikovsky** teaches a method in accordance with claim 7, wherein said identification of the calling party is based on registered caller IDs (a telephone notebook) comprised by the communication (Figure 2, label 106).

As to Claims 26,30,34,38, **Mizikovsky** teaches a portable terminal in accordance with claim 25, wherein said step of taking response action comprises sending a reply to the caller, said reply being a voice message (one of the following: a voice message, e-mail message, facsimile, and an SMS message in the form of a character string) (Col. 8, lines 51-59).

10b.2. Claims 2,6 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky** in view of **Jambhekar et al.** (US 5,848,356).

As to Claims 2,6, **Mizikovsky** teaches a method in accordance with Claim 1, wherein the portable terminal sends said reply immediately in response to an incoming call, and said plurality of forms of communication include a voice message:

Mizikovsky does not teach the following limitation:

“an e-mail message, a facsimile message, and an SMS message in the form of a character string”

However, it is obvious that **Mizikovsky** suggests the limitation. This is because **Mizikovsky** teaches other accessory responses illustrated as peripherals could be used (Col. 7, lines 6-12). In particular, **Mizikovsky** teaches a facsimile peripheral which suggests a facsimile accessory and facsimile message; a multimedia terminal which suggests an e-mail accessory and

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response; EIA/T1A IS-54 alert messages which suggests a SMS accessory and response.

Jambhekar teaches e-mail, facsimile and SMS messages (Figures 5P and 8A). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add e-mail, facsimile and SMS capabilities to **Mizikovsky's** invention for providing callers with response messages as taught by **Jambhekar's** invention in order not to distract a user by sending pre-programmed responses.

10b.3. Claims 3-5,28,32,36,40 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky** in view of **Bremer** (US 6,018,671).

As to Claim 3, **Mizikovsky** teaches a method in accordance with Claim 1, wherein in response to an incoming call,

Mizikovsky does not teach the following limitation:

“the portable terminal alarms and waits during a certain delay, and if a user during said delay does not answer said call, the portable terminal sends said reply”

However, it is obvious that **Mizikovsky** suggests the limitation. This is because **Mizikovsky** teaches providing users with alert signals and, therefore, waits for a user response (Figure 5, label 510). **Bremer** teaches the limitation (Figure 4, labels 416,420). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add default capability to **Mizikovsky's** invention for providing callers with default messages as taught by **Bremer's** invention in order not to keep a caller waiting.

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As to Claims 4,28,32,36,40, **Mizikovsky** teaches a method in accordance with claim 1, wherein in response to an incoming call, the portable terminal alarms, and:

Mizikovsky does not teach the following limitation:

“if a user gives a certain key command, the portable terminal sends said reply”

However, it is obvious that **Mizikovsky** suggests the limitation. This is because **Mizikovsky** teaches providing users with alert signals and, therefore, waits for a user response (Figure 5, label 510). **Bremer** teaches the limitation (Figure 4, labels 416,418). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add selected message capability to **Mizikovsky**'s invention for providing callers with selected messages as taught by **Bremer**'s invention in order not to keep a caller waiting.

As to Claim 5, **Mizikovsky** teaches a method in accordance with claim 3, wherein the portable terminal gives a mute soundless alarm (Col. 6, lines 43-50).

10b.4. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky** in view of **Villa-Real** (US 4,481,382).

As to Claim 14, **Mizikovsky** teaches a method in accordance with claim 7:

Mizikovsky does not teach the following limitation:

“wherein a reminder to call the identified calling party will be stored into the portable terminal, in order to be presented to a user later”

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However, it is obvious that **Mizikovsky** suggests the limitation. This is because **Mizikovsky** teaches providing selected accessory responses to callers (Figure 5, label 518). **Villa-Real** teaches reminder messages (Col. 1, lines 50-63). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add reminder capability to **Mizikovsky's** invention for alerting users as taught by **Villa-Real's** invention in order to provide reminders to users when calls become due.

10b.5. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky** in view of **Wolff et al.** (US 5,327,486).

As to Claims 15-17, **Mizikovsky** teaches a method in accordance claim 1, wherein said reply includes:

Mizikovsky does not teach the following limitation:

“time information”

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However, it is obvious that **Mizikovsky** suggests the limitation. This is because **Mizikovsky** teaches providing callers with selected user accessory responses (Figure 5, label 518). **Wolff** teaches the limitation (Figures 8-9). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add time capability to **Mizikovsky's** invention for providing callers with selected time-based messages as taught by **Wolff's** invention in order not to keep a caller waiting.

Allowable Subject Matter

(11). Claims 10-11 and 18-19, 21-22, 27, 31, 35, 39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(12) Response to Argument

The 35 USC 102 arguments are directed towards whether **Mizikovsky's** Accessories are internal to the mobile terminal and whether replies to callers are with specific messages.

Are **Mizikovsky's** Accessories internal to the mobile station?

The evidence in Figure 1 clearly supports Examiner's contention that they are internal. For example, the peripherals labeled as 52a-52e are connected to a multi-purpose interface 52. The Accessories labeled as 50 have no such interface. If the Accessories were external as the peripherals, then an interface would be necessary for their interconnection. Since there is no interface for the Accessories, then they are internal to the mobile station.

Also, in Section 10, Response to Arguments section of the 2/17/04 Office Action, Examiner pointed out that the peripherals were shown as common hardware devices whereas the Accessories were labeled and concluded that the Accessories were internal software devices. This conclusion is further supported in Figure 1 where the Accessories are in direct communication with the CPU 40 which is the main component in the mobile station. If the Accessories were external, then the CPU would be in indirect communication with the

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Accessories as shown for communications with the peripherals. Since this is not so, then the Accessories are internal to the mobile station.

The detailed description of **Mizikovsky** also supports Examiner's contention that the Accessories are internal to the mobile station. Throughout the disclosure, **Mizikovsky** teaches that it is the Caller ID Processor which activates the Accessories or Peripherals. In activating the Accessories, no interface is used. In activating the Peripherals, interface 52 is used (see Col. 12, lines 25-37, 51-60 and Col. 13, lines 12-16). Because no interface is required for activating the Accessories, they are internal to the mobile station. Because an interface is required for the Peripherals, they are external to the mobile station.

Therefore, Applicants' argument that **Mizikovsky** does not draw a strong distinction between the Accessories and Peripherals is not convincing as shown above by Examiner. Neither is it conjecture for the same reasons. Furthermore, **Mizikovsky** teaches that elements 12-42 are conventional for mobile cellular stations and details will only be discussed for elements 44,46,48,50 and 52 (Col. 6, lines 7-15). These teachings show that Accessories 50 are internal to the mobile station and the Peripherals are not.

Mizikovsky's teachings at Col. 3, lines 1-5 that peripheral devices may be included in or coupled to the mobile station is further evidence that the accessories are internal and not external to the mobile station. This is because there is no interface for the accessories as there is for the peripherals and other reasons given above. Applicants' argument that the accessories 50 are not part of the mobile station because they have large sizes and weight as the fax machine peripheral suggests two issues.

The first issue is that the caller ID processor 44, caller ID memory 46, alert generator 48 and peripheral interface 52 are also not parts of the mobile station. Yet these elements of **Mizikovsky's** invention together with the conventional elements 12-42 are all parts of the mobile station which function together as the mobile station for processing incoming calls. The conventional elements 12-42 are uncontested as being internal to the mobile station. Similarly, elements 44,46,48 and 52 are uncontested as being internal to the mobile station. Since accessory element 50 is connected similarly to elements 12-42,44,46,48 and 52 and function together as a unit, then accessory element 50 must be internal to the mobile station.

The second issue is that it was not known prior to January 8 1996 (priority date of instant application) to integrate answering machine and recorder functions with telephone functions. **Mizikovsky** recognized this issue and that is why he taught that peripherals may be included in or coupled to the mobile station. This recognition is supported by the fact that **Mizikovsky** teaches the programming of the elements 44,46,48,50 and 52 to achieve telephone and answering machine functions in a mobile station (Col. 6, lines 10-19). This programming of the elements by **Mizikovsky** teaches and supports Examiner's contention that the accessories are software elements that are internal to the mobile station. The fact that the peripherals are shown as common hardware elements having large sizes and weights and the accessories as just written

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labels is further proof that the accessories are former hardware functions that were programmed into the mobile station.

Does **Mizikovsky**'s mobile station send specific replies to callers?

The teachings of **Mizikovsky** clearly supports Examiner's contention that it does so. For example, **Mizikovsky** teaches a user assigning predetermined Accessory responses to particular calling parties (Col. 6, lines 51-67 and Col. 12, lines 20-45). These teachings show that it is the mobile station by itself which is sending accessory responses (replies) to 'this' or 'that' (specific) calling party. In addition, **Mizikovsky** teaches accessory voicemail responses to unwanted callers and wanted callers (Col. 9, lines 12-18). These teachings show that voicemail responses are selectable for particular callers (personalized).

In particular, **Mizikovsky** teaches that it is the mobile station which communicates with a caller using accessory responses (Col. 12, lines 28-35 and 38-44). To communicate with a caller means that replies (responses) are sent to a caller in order to receive information from the caller. Therefore, Applicants' arguments that **Mizikovsky** does not teach sending replies and, in particular, sending personalized messages are not convincing as shown above by Examiner. In addition, the claims do not recite personalized messages.

The 35 USC 103 arguments are all directed towards the secondary references not sending replies to callers and, therefore, cannot be combined with the primary reference of **Mizikovsky**.

Examiner respectfully disagrees because the secondary references were used for other limitations and not for the sending of replies. For example:

Secondary reference **Jambhekar** teaches programming of mobile phones in an analogous way to **Mizikovsky** and the claimed different message types which **Mizikovsky** suggests.

Secondary reference **Bremer** teaches receiving incoming calls at mobile stations in an analogous way to **Mizikovsky** and the claimed delay which **Mizikovsky** suggests.

Secondary reference **Villa-Real** teaches programming of messages in mobile stations in an analogous way to **Mizikovsky** and the claimed reminder messages which **Mizikovsky** suggests.

Secondary reference **Wolff** teaches sending responses to callers from a mobile laptop in an analogous way to **Mizikovsky** and the claimed time information in messages which **Mizikovsky** suggests.

The secondary references are all analogous art because they are all directed towards processing incoming calls and programming of responses. Examiner believes that it was obvious

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to combine **Mizikovsky** with each of the above secondary references to achieve the limitations as given in the 2/17/04 Office Action rejections.

(13) New Ground of Rejection

This Examiner's Answer contains a new Ground of Rejection based on the existing art **Mizikovsky** in Section 10 (b).

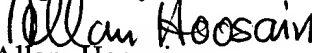
APPELLANT MAY REQUEST THAT:

1. PROSECUTION BE REOPENED BY FILING A 37 CFR 1.111 REPLY; OR
2. REQUEST THAT THE APPEAL BE MAINTAINED BY FILING A REPLY BRIEF.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,


Allan Hoosain

Primary Examiner


Art Unit 2645

May 2, 2005

Conferees


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